



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/583,734 | 05/31/2000 | Avner Shafrir | 52817.000113 | 2781 |

29315 7590 12/22/2003

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILLS ROAD
SUITE 900
RESTON, VA 20190

EXAMINER

HAILU, TADESSE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2173

DATE MAILED: 12/22/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,734

Applicant(s)

Avner Shafrir

Examiner

Tadesse Hailu

Art Unit

2173



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 17, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 19
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2173

DETAILED ACTION

1. This Office Action is in response to the AMENDMENT entered 11/17/2003 for the patent application (09/583,734).
2. The present patent application claims priority from domestic US Application 60/137,513 filed June 2, 1999.
3. The pending claims 1-22 are examined as follows:

Claim Rejections - 35-U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirabilis LTD, Quick Tour, February 12, 1998 in view of ICQ Inc, ICQ Email Signature, May 2, 1999.

ICQ is an application that is used as a tool for communication. After installing this software application in a computer, ICQ allows you to know who is online (network), and allows you to contact them by clicking the name or the icon next to it and then send a message, initiate a chat session or launch any other interactive session (communication mode). ICQ automatically detects user connection to the Internet and announces your presence (on-line status indicator) to those whose list (contact list) you are on and notifies you if your contacts are on-line

Art Unit: 2173

(status indicator) as well. This status indicator is color-coded symbol (flower icon), i.e, it changes to green to announce your presence to those whose list you are on.

Moreover, as described below, it is clear that the current claims are not distinguishable over the cited art.

Per claim 1:

As per "status presenting means," as mentioned above, ICQ, as described and illustrated in Quick Tour, discloses a status presentation means for presenting status indicators associated with corresponding user indicators. ICQ also provides a real-time status of the one or more target users (see Quick Tour, page 5);

as per "communication means," ICQ, as described and illustrated in Quick Tour, discloses communication means for enabling ICQ users to exchange information with a preferred or selected communication mode with a selected indicator (user indicator). Using the Internet, ICQ users can communicate with each other by clicking the name (identifier) or the icon next to it and then send a message, initiate a chat session (real-time) or launch any other interactive session (communication mode) (see Quick Tour, page 6);

As per "user indicator presentation means," ICQ, as described and illustrated in Quick Tour, discloses a user indicator presentation means for presenting a user indicator, such indicator includes among others, a name of a user, the user's numeric id (ICQ#), or any form of identification. As mentioned above these indicators allows a user to establish communication with other users on a network.

Art Unit: 2173

However, ICQ, as described and illustrated in Quick Tour, fails to explicitly describe enabling any other application to generate and present the status indicator within at least one electronic document, wherein the at least one electronic document is generated using any of a plurality of applications. ICQ, in ICQ Email Signature, explicitly describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3 , Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the user indicator (signature) feature to the previous version of ICQ (How to Use ICQ) because it enhances the ICQ communication tool and at the same time this enhancement will benefit the users of both ICQ and non ICQ users as well.

The remaining independent claims, 6, 10, 15 are rejected for the same reason given to claim 1. Claims 21 further calls for "a user indicator presentation module" associated with a first system application and a status determining module associated with a second system application, wherein, the first and second system applications are different system applications. ICQ, as described and illustrated in Quick Tour, also teaches the above limitations, wherein status can be associated with e-mail, chat or data conference applications that determines a status of a user associated with the user indicator (Quick Tour, page 6). Claim 22 further calls for "a status determining module," ICQ, as described and illustrated in Quick Tour, does provide plurality of

Art Unit: 2173

status determining indicators to know the status (online, offline, etc.) of one or more users on the Internet. wherein different applications (such as voice, data sharing application) could be associated with the status of the user (Quick Tour, page 5).

as per claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 17, 19 and 20, ICQ, as mentioned above, does provide several communication mode to a user including e-mail, chat, send and receive message files and URLs, play games, draw on whiteboards, data conference, and communicate through voice while surfing the net (Quick Tour, page 6). User can initiate or establish any one of the communication mode he/she prefers and share at least one application with one or more users (Quick Tour, page 6).

as per claims 3, 8, 12, 18, ICQ automatically updates the user's status (such as online) during connection to the network. After establishing connection user can also customize, change/update their status (Quick Tour, page 5).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 6, 10, 15, 21, and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Tadesse Hailu*, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 8:30 ET. If attempts to reach the

Art Unit: 2173

Examiner by telephone are unsuccessful, the Examiner's supervisor, *John Cabeca*, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

8. The Official fax number is (703) 872-9306.
9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Taddeo Halls

December 11, 2003



JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100